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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,568	11/19/2001	Bernhard Mohr	215850US0PCT	8679

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ALEXANDRIA, VA 22314

EXAMINER

TRUONG, DUC

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,568

Applicant(s)

MOHR ET AL.

Examiner

Duc Truong

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The restriction in the last Office action is hereby withdrawn in view of Applicant's arguments.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mohr et al.

The reference discloses condensation products of basic amino acids with copolymerizable compounds which are obtainable by condensing:

(a) a basic amino acid selected from the group consisting of lysine, arginine, ornithine, tryptophane (see col. 2, lines 1-3, lines 26-42),

(b) a copolymerizable compound selected from the group consisting of saturated monobasic carboxylic acids, unsaturated monocarboxylic acids, polybasic carboxylic acids, carboxylic acid anhydrides, diketenes, monohydroxycarboxylic acids, polyhydroxycarboxylic acids---(see col. 2, lines 4-10, line 43 et seq.).

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Note that the condensation products of basic amino acids with at least one of compounds (b) may optionally contain in condensed form at least one compound (c) selected from the group consisting of amines, lactames, non-proteinogenic amino acids, alcohols, alkoxyated alcohols, alkoxyated amines, amino, sugars, carbohydrates and sugar carboxylic acids (see col. 3, lines 33 et seq).

The disclosure of the reference differs from the instant claims in that it does not disclose the condensed basic amino acid containing polymers would be alkoxyated. That means the reaction products of said basic amino acids (in any forms) with at least one alkylene oxide.

However, the reference does disclose the condensed basic amino acid containing polymers, as in the claims. Further, the reference discloses the use of an optional alcohols or amines or alkoxyated alcohols or alkoxyated amines (see col. 5, lines 3 et seq.). That means the addition products of from 1-20 moles of a C2-C4 alkylene oxide with one mole of alcohol or from 5-30 moles of ethylene oxide with one mole of amines—-(see col. 5, lines 3-18) and base on stoichiometric, the alkylene oxides are in excess and could react with the condensed basic amino acid containing polymers to form the alkoxyated products.

In view of this similarity, it would appear to be inherent that an alkoxyated, condensed basic amino acid containing polymers could be prepared following the teachings of the reference. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

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Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "obtainable" in these claims renders the claims indefinite in that it infers that the condensed basic amino acid containing polymers may be obtained by other means than those claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 703-308-2437. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9791 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DT
April 16, 2003

DUCTRUONG
PRIMARY EXAMINER